

Attorney Docket No.: **RTS-0239**  
Inventors: **Monia et al.**  
Serial No.: **10/002,491**  
Filing Date: **November 15, 2001**  
Page 5

**REMARKS**

Claims 1-20 are pending in this application. The Examiner has made a restriction requirement under 35 U.S.C. §121 and 37 C.F.R. 1.141. The antisense sequences listed in claim 3 are subject to restriction. It is suggested that claim 3 specifically claims antisense SEQ ID NOS 11, 13-20, 22, 25-28, 30, 32-42, 44, 45, 49-59, 64, 66-75, 78, 80, 82-85, 87 and 88, which are targeted to and modulate the expression of a nucleic acid encoding human FXR. The Examiner suggests that although the antisense sequences claimed each target and modulate expression of the same gene the sequences are considered to be unrelated as each sequence is suggested to be structurally and functionally independent and distinct. It is suggested that each sequence has a unique nucleotide sequence and that each antisense sequence targets a different and specific region of a nucleic acid encoding human FXR and each antisense upon binding to a nucleic acid encoding human FXR. Further, the Examiner suggests that a search of more than one of the antisense sequences claimed in claim 3 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search. Applicants respectfully traverse this restriction requirement.

The criteria which must be met for a restriction requirement to be proper are set forth in MPEP §803 and include: (1) that the

Attorney Docket No.: **RTS-0239**  
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Serial No.: **10/002,491**  
Filing Date: **November 15, 2001**  
Page 6

inventions be independent or distinct and (2) that there would be a serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." Clearly all of the sequences in claim 3 of this application contain the same elements or technical features, namely, the ability to modulate human FXR, and therefore these sequences do not meet the MPEP definition of distinct.

Further, there would be no burden on the Examiner due to additional searching, if the restriction is not made. Clearly any search performed to identify art relating to human FXR modulation would identify any relevant art to all of the sequences.

Accordingly, since the instant restriction requirement fails to meet either of the two criteria for proper restriction, reconsideration and withdrawal of the requirement is respectfully requested. However, in an earnest effort to be completely responsive and to facilitate prosecution, Applicants have canceled claim 3 to facilitate the prosecution. Applicants retain th right

Attorney Docket No.: RTS-0239  
Inventors: Monia et al.  
Serial No.: 10/002,491  
Filing Date: November 15, 2001  
Page 7

to pursue the canceled subject matter at a later date, in a continued application.

Respectfully submitted,

*Jane Massey Licata*

Jane Massey Licata  
Registration No. 32,257

Date: June 2, 2003

Licata & Tyrrell P.C.  
66 E. Main Street  
Marlton, New Jersey 08053

(856) 810-1515